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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT PAPER NUMBER

3626

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/725,406

Applicant(s)

GOLDSTEIN, STEVEN

Examiner

Alexander Kalinowski

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet: 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-44 are presented for examination.

#### ***Specification***

2. The abstract of the disclosure is objected to because the abstract contains more than 150 words. Correction is required. See MPEP § 608.01(b).

#### ***Claim Rejections - 35 USC § 101***

Claims 23-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology (e.g. computer system) within the recited steps of the claimed method of

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providing support or care to persons undergoing a surgical procedure. The recited steps constitute an idea on how to carry out the steps for a pre and post operative support and care procedure.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case the claimed method recites steps for creating a managing insurance policy backed securities.

Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claims 23-36 are deemed to be directed to non statutory subject matter. The Examiner suggests that Applicant include language in some of the body of the claim limitations of the independent claims to indicate that some means of technology (i.e. computer or data processing means) is used carry out the method.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 15-34, and 37-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bro, pat. No. 6,249,809 in view of Joao, Pat. No. 6,283,761.

As to claim I, Bro discloses a system for providing support and care to persons considering or undergoing a medical procedure (see abstract), comprising means for receiving, processing and providing information regarding said persons to and from said persons and said medical practitioners (see Fig. 2 and col. 3, lines 29-39), means for providing information and positive reinforcement to said persons regarding said medical procedure being considered or undergone (i.e. motivational and/or informational messages)(col. 3, lines 29-39, and means for receiving, processing and delivering care orders and medicaments from said medical practitioners to said persons (col. 7, lines 34-38, col. 8, lines 25-29, col. 9, lines 5-21 and col. 10, lines 12-20).

Bro does not explicitly disclose means for scheduling and coordinating medical consultations and said medical procedure between said persons and said medical practitioners.

However, Joao discloses means for scheduling and coordinating medical consultations and said medical procedure between said persons and said medical practitioners (col. 32, lines 47-52). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include means for scheduling and coordinating medical consultations and said medical procedure between said persons and said medical practitioners as disclosed by Joao within the Bro system for the

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motivation of providing improved health care quality and efficient information collection (col. 2, lines 46-54).

As to claim 2, Bro discloses the system of Claim 1, further comprising means for monitoring said persons' adherence to said medical practitioners' care orders, medical consultation and medical procedure schedules and medicament prescriptions (i.e. patient appointment reminders, refill reminders)(col. 9, lines 33-41 and col. 10, lines 13-19).

As to claim 3, Bro and Joao do not explicitly disclose the system of Claim 1, further comprising means for receiving, transmitting and processing said persons' financial/credit information to a lender for medical procedure financing.

However, the Examiner takes official notice that it was well known in the electronic commerce arts to transmit and process a person's financial information to third party banks or lenders to obtain financing. The motivation for processing financial information was to insure that a service/goods provider would be paid for services/goods rendered to a person. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include means for receiving, transmitting and processing said persons' financial/credit information to a lender for medical procedure financing within the Bro and Joao combination for the motivation stated above.

As to claim 4, Bro discloses the system of Claim 1, further comprising means for requesting and obtaining said persons' insurer or other third party payor authorization

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for payment of said medical consultations and procedures (i.e. service authorization)(col. 9, lines 42-52).

As to claim 5, Bro does not explicitly disclose the system of Claim 1, further comprising means for processing data regarding sales of medicaments and completion of financing transactions for said medical procedure by said medical practitioner and processing of payments due to said medical practitioner based on said sales of medicaments and financed procedures.

However, Joao discloses means for processing data regarding sales of medicaments and completion of financing transactions for said medical procedure by said medical practitioner and processing of payments due to said medical practitioner based on said sales of medicaments and financed procedures (col. 37, lines 36 - col. 38, line 8). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include means for processing data regarding sales of medicaments and completion of financing transactions for said medical procedure by said medical practitioner and processing of payments due to said medical practitioner based on said sales of medicaments and financed procedures as disclosed by Joao within the Bro system for the motivation of providing healthcare information which can be used to administer and maintain financial accounts of patients and providers (col. 10, lines 49-55).

As to claim 6, Bro discloses the system of Claim 1, wherein said means for receiving, processing and providing information regarding said persons further

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comprises a network of computer systems (i.e. internet)(Fig. 5A and col. 6, lines 23-27 and lines 39-67, and col. 7, lines 10-15).

As to claim 7, Bro discloses the system of Claim 1, wherein said means for receiving, processing and providing information regarding said persons further comprises a voice telephony system permitting communication between said medical practitioner and said patient (col. 6, lines 62-64 and col. 8, lines 15-20).

As to claim 8, Bro discloses the system of Claim 1, wherein said means for receiving, processing and providing information regarding said persons further comprises a facsimile communications system permitting communication between said medical practitioner and said patient (i.e. Fax on demand)(col. 8, lines 25-30).

As to claim 15, Bro discloses the system of Claim 1, wherein said means for providing information and positive reinforcement to said persons regarding said medical procedure being considered or undergone further comprises kits assembled and delivered to said persons containing said information (col. 8, lines 25-29).

As to claim 16, Bro discloses the system of Claim 15, Bro discloses wherein said kits include information regarding said medical practitioner who will perform said medical procedure (col. 9, lines 59-65).

As to claim 17, Bro discloses the system of Claim 15, wherein said kits include information regarding self-care measures for said person to undertake (col. 8, lines 25-30 and col. 9, lines 5-21).

As to claim 18, Bro and Joao do not explicitly discloses the system of Claim 15, wherein said kits include medicaments to be used by said person.



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However, the Examiner takes official notice that it was well known in the medical supplies arts to assemble or package kits including medicaments to be used by persons. For example, many vitamin manufacturers allow users to electronically access web sites to place orders for vitamins that are deemed necessary for the users. The manufacturers are able to process the orders, package the ordered vitamins including materials describing the ordered items, information/brochures/fact sheets about other available but not ordered items, incentives for subsequent orders and information about the company. The motivation for assembling kits including the ordered vitamins was to provide convenient and secure mailing of the ordered vitamins and provide incentives for the user to place additional orders with that particular manufacturer. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include said kits include medicaments to be used by said person within the Bro and Joao combination for the motivation stated above.

As to claims 19-34, and 37-44, the claims are similar in scope to claims 1-8 and 12-18 and are rejected on the same basis.

5. Claims 9-11, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bro and Joao as applied to claim 1 above, and further in view of Iliff, Pat. No. 5,935,060.

As to claim 9, Bro discloses the system of Claim 1, wherein said means for receiving, processing and providing information regarding said persons to and from said persons and said medical practitioner to assess said person's physical and psychological/psychiatric characteristics in order to identify said person's needs for

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medical care (col. 3, lines 29-39 and col. 6, line 67 - col. 7, line 6 and col. 8, lines 47-56).

Bro and Joao do not explicitly disclose means for receiving, processing, and providing information further comprises a structured query protocol

However Iliff discloses means for receiving, processing, and providing information further comprises a structured query protocol (see Fig. 8A). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include means for receiving, processing, and providing further comprises a structured query protocol as disclosed by Iliff within the Bro and Joao combination for the motivation of automating the process of diagnosing by the use of lists that can be processed to generate a dialogue with patients and permit universal unrestricted access to medical information (col. 1, lines 35-45 and line 66 - col. 2, line 9).

As to claim 10, Bro discloses the system of Claim 1, wherein said means for receiving, processing and providing information regarding said persons to and from said persons and said medical practitioner designed to allow said medical practitioner to assess said person's physical and psychological/psychiatric characteristics in order to identify said person's needs for information regarding said medical procedure care (col. 3, lines 29-39 and col. 6, line 67 - col. 7, line 6 and col. 8, lines 47-56).

Bro and Iliff do not explicitly disclose means for receiving, processing and providing information further comprises a structured query protocol.

However, Iliff discloses means for receiving, processing and providing information further comprises a structured query protocol (see Fig. 8A). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include means for receiving, processing, and providing further comprises a structured query protocol as disclosed by Iliff within the Bro and Joao combination for the motivation of automating the process of diagnosing by the use of lists that can be processed to generate a dialogue with patients and permit universal unrestricted access to medical information (col. 1, lines 35-45 and line 66 - col. 2, line 9).

As to claim 11, Bro discloses the system of Claim 1, wherein said means for receiving, processing and providing information regarding said persons to and from said persons and said medical practitioner further comprises a structured query protocol designed to allow said medical practitioner to assess said person's physical and psychological/psychiatric characteristics in order to identify said person's needs for positive reinforcement care (col. 3, lines 29-39 and col. 6, line 67 - col. 7, line 6 and col. 8, lines 47-56).

Bro and Joao do not explicitly disclose means for receiving, processing and providing information further comprises a structured query protocol.

However, Iliff discloses means for receiving, processing and providing information further comprises a structured query protocol (see Fig. 8A). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include means for receiving, processing, and providing further comprises a structured

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query protocol as disclosed by Iliff within the Bro and Joao combination for the motivation of automating the process of diagnosing by the use of lists that can be processed to generate a dialogue with patients and permit universal unrestricted access to medical information (col. 1, lines 35-45 and line 66 - col. 2, line 9).

As to claims 35-36, the claims are similar in scope to claims 9-11 and are rejected on the same basis.

6. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bro and Joao as applied to claim 1 above, and further in view of Lade, Diane, "Cyber Docs people with a wide range of medical problems are finding support online from doctors and other patients themselves" (hereinafter Cyber Docs).

As to claim 12, Bro does not explicitly disclose the system of Claim I, wherein said means for providing information and positive reinforcement to said persons regarding said medical procedure being considered or undergone comprises a website accessible via a network of computer systems connected by common protocols, said website having a searchable database containing information regarding said medical procedure being considered.

However Joao discloses wherein said means for providing information and positive reinforcement to said persons regarding said medical procedure being considered or undergone comprises a website accessible via a network of computer systems connected by common protocols (i.e. internet)(col. 11, line 66 - col. 12, line 5, col. 13, lines 39-50 and col. 15, lines 6-25). Joao further discloses said website having a searchable database containing information regarding said medical procedure being

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considered (i.e. database 10H)(col. 17, lines 25-61). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include means for providing information and positive reinforcement to said persons regarding said medical procedure being considered or undergone comprises a website accessible via a network of computer systems connected by common protocols, said website having a searchable database containing information regarding said medical procedure being considered within the Bro system for the motivation of providing healthcare information and treatment information in a networked environment, thereby providing on demand anytime, anywhere access to medical information to a patient (col. 8, lines 14-26 and lines 43-53).

Bro and Joao do not explicitly disclose wherein information is provided without obligation or requiring persons using the system to disclose their identities or other personal information, thereby fostering a sense of comfort and trust in the person considering undergoing said medical procedure.

However, Cyber Doc discloses wherein information is provided without obligation or requiring persons using the system to disclose their identities or other personal information, thereby fostering a sense of comfort and trust in the person considering undergoing said medical procedure (i.e. patients don't risk losing their anonymity)(page 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein information is provided without obligation or requiring persons using the system to disclose their identities or other personal information, thereby fostering a sense of comfort and trust in the person considering undergoing said

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medical procedure as disclosed by Cyber Docs within the Bro and Joao combination for the motivation of not embarrassing the patient (page 2).

As to claim 13, Bro and Joao do not explicitly disclose the system of Claim 12, wherein said information provided through said website comprises accounts of the personal experiences of persons who have undergone the medical procedure under consideration.

However, Cyber Docs discloses wherein said information provided through said website comprises accounts of the personal experiences of persons who have undergone the medical procedure under consideration (i.e. connecting with someone whose experiences mirror their own)(page 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said information provided through said website comprises accounts of the personal experiences of persons who have undergone the medical procedure under consideration as disclosed by Cyber Docs within the Bro and Joao combination for the motivation of providing access to medical information to patients with no access or support (page 2).

As to claim 14, Bro discloses the system of Claim 12, further comprising means for accessing a live attendant that can provide additional information, assist with selection of a medical practitioner and coordinate scheduling of an initial consultation with the selected medical practitioner upon request by persons using the system (col. 9, lines 22-41).

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**Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. "Changing their Role ..." discloses celebrity doctors using Internet web sites to dispense medical advice.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Primary Examiner

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12/3/03